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EXAMINER

DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 07/01/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,629

Applicant(s)

KIMURA, JUNICHI

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-16 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

1. Claims 1-16 have been examined.

Priority

2. Receipt is acknowledged of a paper submitted under 35 U.S.C. 119(a)-(d), which paper has been placed of record in the file.
3. Acknowledgment is made for the benefit of an earlier filing date of Application No. 2000JP-222389 filed in Japan on 07/18/2000.

Drawings

4. Figures 1-5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claim 6 is objected to because of the following informalities: after "external" in page 39, line 17, insert --terminal--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: those between the charge processor unit and the camera and between the charge processor unit and the processor unit.

8. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said ID" in page 42, lines 14. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting "ID" in page 42, line 14 and replacing with --IDs--.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 16 recites the limitation "said video" in page 43, lines 20. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting "video;" in page 43, line 20 and replacing with --video bitstream;--.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000 or a U.S. patent with no common inventors nor common assignees resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do apply when the reference is a U.S. patent with either at least one common inventors or at least one common assignee. See MPEP § 706.02(i).

(f) he did not himself invent the subject matter sought to be patented.

11. Claims 2, 12, 13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A.

As per claim 2, Itoh et al. show a video information generating apparatus comprising:
means for creating [see specification, page 10, lines 4-8; figure 7, item 23; an encoder unit creating] video bitstream operable in condition that the appropriate fee has been paid or will be positively paid as soon as possible (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 24, 26, 34, and 28; satellite broadcasting tuner, CATV tuner, a laser disk player (LDP), and a videotape recorder for receiving video signals; see column 5, lines 62-67; figure 1, item 8; where it must go through a charge information decoder to check for required charges to be paid or billed); and

means for creating [see specification, page 10, lines 20-25; figure 7, item 135; a copy protection code manager creating] output of a copy protection code corresponding to the paid fee together with the video bitstream (see computer translation; Detailed Description; ¶ [0006]; figure 1, item 11; a copy guard circuit for providing copy preventative information).

The “means for creating” limitations explicitly recited in claim 2 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP

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§ 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 12, Itoh et al. describe a multimedia communication terminal apparatus, comprising:

means for receiving and storing [see specification, page 16, lines 15-17; figure 11, item 161; a transmitter receiving and storing] an ID code specifying a video bitstream created and stored in a storage of a server (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 2; accounting information is received and stored at the Satellite Broadcasters or CATV office);

means for creating [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter creating] a destination text (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 7 and drawing 2; the accounting information is modified so that the selected signal is outputted to be recorded and reproduced by recording device); and

means for transmitting [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter transmitting] the ID and the destination to the server to distribute the video bitstream specified by the ID to the destination by the server (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 15 and drawing 2; the accounting information is transmitted through MODEM for tariff collection).

The “means for receiving and storing,” “means for creating,” and “means for transmitting” limitations explicitly recited in claim 12 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C.

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§ 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 13, Itoh et al. illustrate a video distribution server, comprising:

means for receiving and storing [see specification, page 16, lines 9-14; figure 11, item 123; a storage device for receiving and storing] video encoded bitstream created and first ID uniquely specifying the video (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 2; signal with accounting information is received and stored at the Satellite Broadcasters or CATV office);

means for receiving [see specification, page 16, lines 19-23; figure 11, item 163; a distribution server for receiving] from a communication terminal a transmission request including the destination and second ID identifying the video (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, items 15 and 21; signal with accounting information is transmitted to the tariff collection containing the ID number),

retrieving from the storage a video having first ID matched with second ID (see computer translation; Detailed Description; ¶¶ [0014]-[0015]; drawing 1, items 21, 23, and 27; the received accounting information including the identifier of the signal purchased is settled the corresponding signal is retrieved)

forwarding the appropriate video to the destination (see computer translation; Detailed Description; ¶ [0016; drawing 1, items 24 and 24; receiving the signal from station offices through tuners).

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The “means for receiving and storing” and “means for storing” limitations explicitly recited in claim 13 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 16, Itoh et al. show a video information generating apparatus comprising:
means for creating [see specification, page 10, lines 4-8; figure 7, item 23; an encoder unit creating] video bitstream in condition that the appropriate fee has been paid or will be positively paid soon (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 24, 26, 34, and 28; satellite broadcasting tuner, CATV tuner, a laser disk player (LDP), and a videotape recorder for receiving video signals; see column 5, lines 62-67; figure 1, item 8; where it must go through a charge information decoder to check for required charges to be paid or billed);

means for outputting [see specification, page 10, lines 20-25; figure 7, item 135; a copy protection code manager creating] video bitstream with a copy protection code corresponding to the paid fee (see computer translation; Detailed Description; ¶ [0006]; figure 1, item 11; a copy guard circuit for providing copy preventative information);

means for outputting [see specification, page 17, lines 15-24; figure 13, item 172; a communication interface for transmitting] ID identifying the video (see computer translation; Example; ¶ [0022]; drawing 1, item 7 and drawing 2; transmitting the ID to the record signal output circuit);

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a video distribution server for receiving and storing the video encoded bitstream created and ID uniquely specifying the video bitstream (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 2; signal with accounting information is received and stored at the Satellite Broadcasters or CATV office);

a multimedia communication terminal apparatus for receiving and storing the ID code specifying a video bitstream created and stored in a storage of a server (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 2; accounting information is received and stored at the Satellite Broadcasters or CATV office);

means for creating [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter creating] a destination (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 7 and drawing 2; the accounting information is modified so that the selected signal is outputted to be recorded and reproduced by recording device);

means for transmitting [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter transmitting] the ID and the destination to the server to distribute the video bitstream specified by the ID to the destination by the server (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 15 and drawing 2; the accounting information is transmitted through MODEM for tariff collection); and

the video distribution server further comprising:

means for comparing [see specification, page 21, lines 5-11; figure 15, item 205; video & audio ID manager comparing] the ID and destination received from the first multimedia communication terminal with the ID received from the video information generating apparatus to retrieve a corresponding video bitstream in the storage (see computer translation; Detailed

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Description; ¶¶ [0014]-[0015]; drawing 1, items 21, 23, and 27; the received accounting information including the identifier of the signal purchased is settled when the identifiers match the corresponding signal is retrieved),

in order to distribute the appropriate video bitstream to a second multimedia communication terminal specified by the destination (see computer translation; Detailed Description; ¶ [0016; drawing 1, items 24 and 24; receiving the signal from station offices through tuners).

The two “means for creating,” the two “means for outputting,” the “means for transmitting,” and the “means for comparing” limitations explicitly recited in claim 16 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

12. Claims 2 is rejected under 35 U.S.C. 102(e) and (f) as being anticipated by Yoshizawa et al., U.S. Patent No. 6,002,694 A.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

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As per claim 2, Yoshizawa et al. illustrate a video information generating apparatus comprising:

means for creating [see specification, page 10, lines 4-8; figure 7, item 23; an encoder unit creating] video bitstream operable in condition that the appropriate fee will be positively paid as soon as possible (see column 11, lines 45-58; figure 4, items 414 and 415; a coding circuit to code and multiplex the video with the billing check circuit producing a billing information for the program reception free on the basis of the program information); and

means for creating [see specification, page 10, lines 20-25; figure 7, item 135; a copy protection code manager creating] output of a copy protection code corresponding to the paid fee together with the video bitstream (see column 12, lines 65-67; column 13, lines 1-4; figure 5, item 568; a copy guard circuit for processing the video signal such that it can not be recorded by the video signal recording/reproducing apparatus for displaying the program video output in accordance with the billing information).

The “means for creating” limitations explicitly recited in claim 2 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

13. Claims 10 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanota et al., U.S. Patent No. 5,991,500 A.

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As per claim 10, Kanota et al. illustrate a multimedia communication terminal apparatus, comprising:

a storage device for storing video forwarded from the outside (see column 7, lines 65-67; column 8, line 1; figure 18, items 1 and 2; a video signal received from the outside with a tuner; see column 8, lines 14-18; video signal is recorded by recorder);

a storage unit for storing the copy protection code of the video bitstream forwarded from the outside (see column 7, lines 65-67; column 8, line 1; figure 18, items 1 and 2; TABLE 1; copyright information and copy generation signals S_1 and S_2 are received from the outside with a tuner; see column 8, lines 14-18; copyright information and copy generation signals S_1 and S_2 are recorded by recorder);

transmitter means for transmitting [see specification, page 19, lines 13-17; figure 15, item 207; the transmitter for transmitting] the video stored in the storage device; (see column 8, lines 19-21; figure 18, items 2 and 3; a connector for supplying the video signal for re-recording); and

controller means for allowing [see specification, page 20, lines 17-23; figure 15, item 206; video & audio ID manager unit for allowing] the transmission of the video by the transmitter means [see specification, page 19, lines 13-17; figure 15, item 207; the transmitter for transmitting] until the number of times of transmissions reaches a value of the copy protection code (see column 8, lines 47-63; figure 19, items 5 and 6; transmitting until S_1 and S_2 equal 1 and 1, respectively), and for inhibiting the transmission when the number of transmissions becomes equal to the value of the copy protection code (see column 8, lines 64-67; column 9, lines 1-6; figure 19, items 5 and 6; inhibiting the transmission when S_1 and S_2 equal 1 and 1, respectively, by inhibiting the receiving recorder to record the video signal).

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The “transmitter means” and “controller means” limitations explicitly recited in claim 10 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 11, Kanota et al. depict a multimedia communication terminal apparatus, comprising:

a copy protection code manager for managing the number of copies by extracting the copy protection code from the video bitstream when receiving the video bitstream with a copy protection code appended (see column 7, lines 65-67; column 8, line 1; figure 18, items 1 and 2; TABLE 1; copyright information and copy generation signals S_1 and S_2 are superposed on the video signal; see column 8, lines 37-52; figure 19; items 4 and 5; copyright information and copy generation signals S_1 and S_2 indicate to the recorder upon extraction whether recording is permitted); and

a controller for inhibiting the transmission when the number of allowed copies becomes 0 (see column 8, lines 64-67; column 9, lines 1-6; figure 19, items 5 and 6; inhibiting the transmission when S_1 and S_2 equal 1 and 1, respectively, by inhibiting the receiving recorder to record the video signal).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 3, and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Jung et al., U.S. Patent No. 4,862,290 A.

As per claim 1, Itoh et al. depict a video information generating apparatus comprising:
a charge processor unit (see column 5, lines 21-24; figure 1, items 14, 16, and 17; a charging circuit for settling the charged amount for the video with an IC card storing electronic money);

a satellite broadcasting tuner, a CATV tuner, a laser disk player (LDP), and a videotape recorder operable in condition that an appropriate fee has been paid for creating video bitstream (see computer translation; Detailed Description; ¶ [0006]; figure 1, items 24, 26, 34, and 28; satellite broadcasting tuner, CATV tuner, a laser disk player (LDP), and a videotape recorder for receiving video signals; see computer translation; Detailed Description; ¶ [0013]; figure 1, item 8; where it must go through a charge information decoder to check for required charges); and

a processor unit for adding a copy protection code corresponding to the paid fee to the video bitstream created by the satellite broadcasting tuner, the CATV tuner, the laser disk player

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(LDP), and the videotape recorder to output (see computer translation; Detailed Description; ¶ [0006]; a copy guard circuit for providing copy preventative information).

However Itoh et al. do not explicitly teach using a camera.

Jung et al. disclose a camera providing a video signal alternatively to a tuner (see column 2, lines 40-50; figure 1, items 40 and 30; a tuner and camera for providing video signals).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Itoh et al. with the camera of Jung et al. for the user to choose between live video and original programming (see column 1, lines 23-28).

As per claim 3, Itoh et al. depict a video information generating apparatus comprising:

a communications interface connectable to an external terminal (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 13 and 19; a digital signal output circuit is connected to a digital TV for receiving digital signals);

a charge processor unit (see computer translation; Detailed Description; ¶ [0015]; figure 1, items 14, 16, and 17; a charging circuit for settling the charged amount for the video with an IC card storing electronic money);

a laser disk player (LDP) and a videotape recorder operable in condition that an appropriate fee has been paid for creating video bitstream (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 34 and 28; a laser disk player (LDP), and a videotape recorder for receiving video signals; see computer translation; Detailed Description; ¶ [0002]; where viewers desire to reproduce only main video information with an amount of charge decided according to the first charging information; see computer translation; Detailed

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Description; ¶ [0006]; figure 1, item 8; where it must go through a charge information decoder to check for required charges; see computer translation; Detailed Description; ¶ [0015]; figure 1, items 14, 16, and 17; a charging circuit for settling the charged amount for the video with an IC card storing electronic money);

a display for displaying the recorded video bitstream (see computer translation; Detailed Description; ¶ [0009]; figure 1, items 13 and 19; a digital TV for rendering the digital signals);

a processor unit for adding a copy protection code corresponding to the paid fee to the video bitstream created by the satellite broadcasting tuner, the CATV tuner, the laser disk player (LDP), and the videotape recorder to output (see computer translation; Detailed Description; ¶ [0006]; figure 1, item 11; a copy guard circuit for providing copy preventative information); and

means for feeding [see specification, page 11, lines 18-20; user mobile terminal feeding] to the external terminal device through the interface the video bitstream added to the copy protection code in correspondence with the amount paid in response to the instruction of the user indicating that the video displayed is acceptable (see computer translation; Detailed Description; ¶ [0006]; figure 1, item 22; a decoder IC card to control the decoder in accordance with the user's choice of programming).

However Itoh et al. do not explicitly teach using a camera.

Jung et al. disclose a camera providing a video signal alternatively to a tuner (see column 2, lines 40-50; figure 1, items 40 and 30; a tuner and camera for providing video signals).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Itoh et al. with the camera of Jung et al. for the user to choose between live video and original programming (see column 1, lines 23-28).

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The “means for feeding” limitation explicitly recited in claim 3 is construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 5, Itoh et al. further elaborate:

means for selecting [see page specification, page 12, lines 3-5; a touch screen or key for selecting] a background (see computer translation; Detailed Description; ¶ [0011]; figure 3, item 42; a switch to select between commercial video information and main video information); and synthesizer for synthesizing the video recorded bitstream with a selected background (see computer translation; Detailed Description; ¶ [0011]; figure 3, item 43; a scrambler scrambling the commercial video information together with the main video information).

The “means for selecting” limitation explicitly recited in claim 5 is construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 6, Itoh et al. additionally explain:

that an audio bitstream is obtained is feed to the external terminal device along with the video bitstream (see computer translation; Detailed Description; ¶ [0011]; figure 6, items 34, 35, and 43; the audio information is scrambled together with the video information).

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However, Itoh et al. do not explicitly show that the audio bitstream is obtained from the camera.

Jung et al. disclose that the camera provides audio and video signals (see column 2, lines 44-49; figure 1, item 40).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Itoh et al. with the camera providing video and audio bit streams of Jung et al. for the user to choose between live video and original programming (see column 1, lines 23-28).

As per claim 7, Itoh et al. describe a video information generating apparatus comprising:
a video recorder for video recording for a predetermined period of time to creating a video bitstream in response to a start recording instruction from a user in condition that the corresponding fee is paid or positively charged (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 7, 8, and 28; user selects the signal to be recorded through the record signal output circuit with the charge information decoder; see computer translation; Detailed Description; ¶ [0007]; figure 1, items 14, 16, 17, and 21; where a charging circuit settles with an IC card storing electronic money or charges the charged amount for the video; see computer translation; Detailed Description; ¶ [0008]; figure 1, item 10; for a duration governed by a timer);
and

means for generating [see specification, page 17, lines 10-11; figure 13, item 170; an ID management unit for generating] an ID uniquely identifying the video for each recorded video (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 7 and drawing 2; the

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accounting information is modified so that the selected signal is outputted to be recorded and reproduced by recording device); and

a transmitter means [see specification, page 18, lines 15-18; figure 13, item 132; a communication interface for transmitting] for transmitting the ID to a terminal (see computer translation; Example; ¶ [0022]; drawing 1, item 7 and drawing 2; transmitting to the record signal output circuit) and for transmitting the ID and the video recorded bitstream to a server (see computer translation; Example; ¶¶ [0021]-[0022]; drawing 1, item 15, 23, and 27 and drawing 2; the accounting information is transmitted through MODEM for tariff collection and the signal is transmitted to the satellite broadcasting service and CATV service).

However, Itoh et al. do not explicitly show that the audio bitstream is obtained from the camera.

Jung et al. disclose that the camera provides audio and video signals (see column 2, lines 44-49; figure 1, item 40).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Itoh et al. with the camera providing video and audio bitstreams of Jung et al. for the user to choose between live video and original programming (see column 1, lines 23-28).

The “means for generating” and “transmitter means” limitations explicitly recited in claim 7 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

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As per claim 8, Itoh et al. further point out:

that a copy protection code corresponding to the amount paid is incorporated into the ID (see computer translation; Example; ¶ [0018]; drawing 2; the accounting information is contains privilege tariff information).

As per claim 9, Itoh et al. depict a video information generating apparatus comprising:
a communications interface connectable to a server (see computer translation; Detailed Description; ¶ [0006]; figure 1, items 23, 25, 26, and 27; a satellite broadcasting tuner and a CATV tuner for receiving a signal from the server at a broadcasting station);

a charge processor unit (see computer translation; Example; ¶ [0018]; drawing 2; a module to add tariff information (cheap tariff or free information) to the accounting information);

a video recorder for video recording for a predetermined period of time to creating a video bitstream in response to a start recording instruction from a user in condition that a fee is deposited to charge processor (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 7, 8, and 28; user selects the signal to be recorded through the record signal output circuit with the charge information decoder; see computer translation; Detailed Description; ¶ [0007]; figure 1, items 14, 16, 17, and 21; where a charging circuit settles with an IC card storing electronic money; see computer translation; Detailed Description; ¶ [0010]; figure 1, item 10; for a duration governed by a timer);

a display for displaying the recorded video bitstream (see computer translation; Detailed Description; ¶ [0006]; figure 1, items 13 and 19; a digital TV for rendering the digital signals);

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a processor unit for adding a copy protection code corresponding to the paid fee to the video bitstream created by the satellite broadcasting tuner, the CATV tuner, the laser disk player (LDP), and the videotape recorder to output (see computer translation; Detailed Description; ¶ [0007]; figure 1, item 11; a copy guard circuit for providing copy preventative information); and

means for feeding [see specification, page 18, lines 15-18; figure 13, item 132; a communication interface for transmitting] to the server through the interface the video bitstream added to the copy protection code in correspondence with the amount paid in response to the instruction of the user indicating that the video displayed is acceptable (see computer translation; Detailed Description; ¶ [0011]; drawing 3, item 47; transmitting the combined signal to the Satellite Broadcasters or a CATV office).

However, Itoh et al. do not explicitly show that the audio bitstream is obtained from the camera.

Jung et al. disclose that the camera provides audio and video signals (see column 2, lines 44-49; figure 1, item 40).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the apparatus of Itoh et al. with the camera providing video and audio bitstreams of Jung et al. for the user to choose between live video and original programming (see column 1, lines 23-28).

The “means for feeding” limitation explicitly recited in claim 9 is construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

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16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A as applied to claim 13 above, and further in view of Kanota et al., U.S. Patent No. 5,991,500 A.

Itoh et al. disclose the video distribution server of claim 13. They further point out: that the IDs include a copy protection code (see computer translation; Example; ¶ [0021]; drawing 1, items 3 and 4; accounting information containing an identifier of the signal and capable of actuation of the descrambler).

However, they do not explicitly teach updating the copy protection code for each time of distribution.

Kanota et al. describe:

a management unit for updating the copy protection code for each time of distribution for inhibiting the transmission of the video when the copy protection code reaches a particular numerical value (see column 8, lines 52-67; column 9, line 1; figure 18, item 2; figure 19, item 5; circuitry in the video recorder is adapted to change over the copy generation signal S2 to inhibit further recording).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the server of Itoh et al. with the management unit of Kanota et al. to provide only one generation of dubbed video signal (see column 9, lines 14-17).

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17. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Kanota et al., U.S. Patent No. 5,991,500 A.

As per claim 15, Itoh et al. depict a video information system, comprising:

a video information generating apparatus having:

means for creating [see specification, page 10, lines 4-8; figure 7, item 23; an encoder unit creating] video bitstream operable in condition that the corresponding fee has been paid or will be positively paid as soon as possible (see computer translation; Detailed Description; ¶ [0007]; figure 1, items 24, 26, 34, and 28; satellite broadcasting tuner, CATV tuner, a laser disk player (LDP), and a videotape recorder for receiving video signals; see column 5, lines 62-67; figure 1, item 8; where it must go through a charge information decoder to check for required charges to be paid or billed);

means for adding [see specification; page 17, lines 21-24; figure 13, item 173; communication interface for adding] copy protection code corresponding to the paid fee to the video bitstream (see computer translation; Detailed Description; ¶ [0006]; figure 1, item 11; a copy guard circuit for adding copy preventative information)

first multimedia communication terminal having:

a storage device for storing the video bitstream transferred from the video information generating apparatus (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 2; signal with accounting information is received and stored at the Satellite Broadcasters or CATV office);

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transmission means [see specification; page 14, lines 15-21; figure 11, item 161; a transmitter] for transmitting the video bitstream stored in the storage device to a specified destination (see computer translation; Detailed Description; ¶¶ [0010]-[0011]; drawing 1, items 23 and 27; drawing 2; signal with accounting information with address is transmitted to the Satellite Broadcasters or CATV office); and

a distribution server for sending the video bitstream transferred from the first multimedia communication terminal to a second multimedia communication terminal as the specified destination (see computer translation; Detailed Description; ¶ [0016; drawing 1, items 24 and 24; receiving the signal from station offices through tuners).

However, Itoh et al. do not explicitly teach inhibiting transmission when the number of allowed copies becomes 0.

Kanota et al. describe:

controller means [see specification, page 20, lines 17-23; figure 15, item 205; a video & audio ID manager] for inhibiting the transmission of the video bitstream through a communication interface when the number of allowed copies becomes 0 (see column 8, lines 64-67; column 9, lines 1-15; figure 19, items 5 and 6; inhibiting the transmission after one generation of a dubbed video signal may be obtained by inhibiting the receiving recorder to record the video signal).

Therefore, it would have been obvious to one of ordinary skill in the computer art at the time the invention was made to combine the system of Itoh et al. with the management unit of Kanota et al. to provide only one generation of dubbed video signal (see column 9, lines 14-17).

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The “means for creating,” “means for adding,” “transmission means,” and “controller means” limitations explicitly recited in claim 15 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

Allowable Subject Matter

18. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Translation

A forensic translation into English of Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A will be provided in the next Office action.

Conclusion

19. The prior art made of record and not relied under 35 U.S.C. § 103(c) upon is considered pertinent to applicant's disclosure.

- Itoh et al., U.S. Patent No. 6,282,293 B1 is a counterpart U.S. Patent to Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A.

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Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (703) 305-3872 and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (703) 305-1830.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only "**OFFICIAL FAX**" but also "**AMENDMENT AFTER FINAL**".

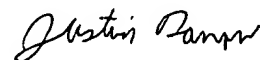
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

June 25, 2004



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